

REMARKS

1. Applicant thanks the Examiner for pointing out the allowable subject matter of Claims
5 1 – 10, 11 – 29 and 49 – 50.

2. It should be appreciated that Applicant has elected to amend Claims 1, 10, 21, 30,
42, 51, 52, 54, and 55 solely for the purpose of expediting the patent application process
10 in a manner consistent with the PTO's Patent Business Goals, 65 Fed. Reg. 54603
(9/8/00). In making such cancellations and amendment, Applicant has not and does not in
any way narrow the scope of protection to which Applicant considers the invention herein to
be entitled. Rather, Applicant reserves Applicant's right to pursue such protection at a later
point in time and merely seeks to pursue protection for the subject matter presented in this
submission.

15 3. Claims 31 – 33 are objected to because their parent Claim doesn't provide an
antecedent for the term "minimizing." As described below, Claim 30 has been amended to
substitute the term "minimizing" for the term "limiting," providing proper antecedent basis
for the subject matter of Claims 31 – 33.

20 4. Claims 30 – 48 and 51 – 56 stand rejected under 35 USC § 112, second
paragraph, as being indefinite for failing to particularly point out and distinctly claim the
subject matter of the invention. The Examiner finds that the term "limiting" in Claims 30, 51,
52, 54 and 55 is a relative term that renders the Claims indefinite. Applicant amends Claim
25 30, 51, 52, 54 and 55 by substituting the expression "minimizing" for "limiting." "Minimizing"
harmonizes the Claims with the specification. Applicant recognizes that the Examiner has
previously rejected Claims containing the term "minimizing," also finding them to be
indefinite. Applicant respectfully disagrees. "The fact that claim language, including terms of
degree, may not be precise, does not automatically render the claim indefinite under 35
30 USC 112, second paragraph." "Acceptability of the Claim language depends on whether
one of ordinary skill in the art would understand what is claimed in light of the specification."
MPEP § 2173.05(b). Applicant provides herewith a Rule 132 Declaration of the inventor
Makarewicz. In said Declaration, Ms. Makarewicz declares that:

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- "Minimize" is a well known term of art in the fields of science and engineering; and

- One having an ordinary level of skill in the art would readily understand the term “minimize” to mean “substantially eliminate”; and
- Within the context of the invention, one skilled in the art would understand that the term “minimize” is used in relation to spectral interference to describe substantially eliminating interference resulting from pressure effects on a spectrum, temperature effects on a spectrum, and sample placement errors, with the end result of optimizing signal-to-noise ratio.

Thus, as it is used here in relation to spectral interference, the term “minimizing” is not a relative term that requires a defined scope. For the sake of convenience, Applicant provides a Declaration from one of the inventors. Should the Examiner deem it necessary, Applicant will provide Declarations of similar scope from the remaining inventors. Accordingly, the rejection under 35 USC § 112, second paragraph is deemed overcome.

5. Claims 1 – 10 stand rejected under 35 USC § 101 as Claiming non-statutory subject matter. Claim 1 has been amended to eliminate the offending language. As amended, Claim 1 describes the configuration of the various elements of the Claimed interface module. Accordingly, the rejection under 35 USC § 101 is deemed overcome.

6. Claims 54 – 55 stand rejected under 35 USC § 102(b) as being anticipated by U.S. Patent No. 5,671,317 (“Weishaupt”). To distinguish the invention from the cited reference more thoroughly, Applicant has amended Claim 54 to describe “minimizing variation in placement of a tissue measurement site in relation to an optical coupling means by means of one or more support elements that receive a member bearing said tissue measurement site”. Support for the amendment is found in Claim 1. In stark contrast, Weishaupt describes a device having a plurality of legs, wherein the legs are attached to the surface bearing the tissue measurement site. As described by amended Claim 54, nothing is attached to the surface bearing the tissue measurement site. Rather, the member, that is, the limb or body part, bearing the tissue measurement site, is received by one or more support elements. There is no teaching or suggestion in Weishaupt of support elements that receive a member bearing the tissue measurement site. Accordingly, the rejection of Claims 54 and 55 under 35 USC § 102(b) is deemed overcome.

7. Claims 30 and 56 stand rejected under 35 USC 103(a) as being unpatentable over U.S. Patent No. 6,064,897 (“Lindberg”) in view of Weishaupt. To distinguish the Claimed invention from the cited references, Applicant has amended Claim 30 as in Claim 54, to

describe “minimizing variation in placement of a tissue measurement site in relation to an optical coupling means by means of one or more support elements that receive a member bearing said tissue measurement site”. While Lindberg teaches “the body part 15 is preferably held by a fixture to insure accuracy of measurement...” no structure for the purpose is shown in the drawings, nor is an enabling description of such a structure provided in the specification. Accordingly, there is no teaching or suggestion of one or more support elements that receive a member bearing said tissue measurement site in the references, either separately or in combination. Thus, the rejection of Claims 30 and 56 under 35 USC 103(a), and all Claims depending therefrom is deemed overcome.

8. Claim 30 has also been amended to describe “wherein signal-to-noise ratio is optimized to facilitate signal detection.” Support for the amendment is found in the specification at page 11, line 1.

9. Claims 10, 21 and 42 are amended to correct punctuation errors.

CONCLUSION

In view of the foregoing, the application is deemed to be in allowable condition. Therefore, the Examiner is earnestly requested to withdraw all rejections and allow the application to pass to issuance as a U.S. Patent. Should the Examiner have any questions concerning the Application, he is urged to contact Applicant's attorney at the telephone number given below.

Respectfully submitted,



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